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OFFICE OF PETITIONS

In re Application of	:	
William Gordon	:	
Application No. 10/821,065	:	DECISION ON PETITION
Filed: April 8, 2004	:	TO MAKE SPECIAL UNDER
Attorney Docket No. GOR101	:	37 CFR 1.102(c)(2)
	:	

This is a decision on the petition under 37 CFR 1.102(c)(2)(iii), filed September 8, 2005, to make the above-identified application special based on the invention materially contributing to countering terrorism as set forth in M.P.E.P. § 708.02, Section XI.

The petition is **DISMISSED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(2)(iii) and MPEP § 708.02, Section XI: Inventions for Countering Terrorism, should state that special status is sought because the invention materially contributes to countering terrorism. International terrorism as defined in 18 U.S.C. 2331 includes:

activities that - (A) involve violent acts or acts dangerous to human life that are a violation of the criminal laws of the United States or of any State, or that would be a criminal violation if committed within the jurisdiction of the United States or of any State; [and] (B) appear to be intended - (i) to intimidate or coerce a civilian population; (ii) to influence the policy of a government by intimidation or coercion; or (iii) to affect the conduct of a government by assassination or kidnapping...

If the disclosure is not clear on its face that the claimed invention is materially directed to countering terrorism, the petition must be accompanied by a statement by the applicant, assignee or a registered attorney/agent explaining how the materiality standard is met. The types of technology for countering terrorism could include, but are not limited to, systems for detecting/identifying explosives, aircraft sensors/security systems, and vehicular barricades/disabling systems. No fee is required.

The USPTO's final rule amending 37 CFR 1.102(c)(2) states:

The materiality standard does not permit an applicant to speculate as to how a hypothetical end-user might specially apply the invention in a manner that could counter terrorism. Nor does such standard permit an applicant to enjoy the benefit of advance examination merely because some minor aspect of the claimed invention may be directed to countering terrorism...[Response to Comment 65] applicants should not expect to have their petitions granted without a clear demonstration that the claimed invention is materially related to countering terrorism.

The instant petition fails to meet the criteria of "materially" contributing to countering terrorism as set forth above. The invention relates to a rebreather apparatus for underwater diving. Petitioner states that the invention has uses in countering terrorism and is being tested by the U.S. Department of Homeland Security as evidenced by the attached document, "Unclassified Requirements for the AT-UBA ORD Rev. 2" dated 14 April 2004. While the invention may be beneficial to scuba diving in recreational, commercial, and military applications as stated in the specification, there is no "material" evidence that the invention actually "counters" terrorism as defined in 18 U.S.C. 2331 (repeated above). Further steps would be required to actually offset or nullify terrorism, yet no suggestion of "countering terrorism" is found in the disclosure. While the Department of Homeland Security may find the invention useful, it is only one of many uses that needs to be specially applied to the invention since countering terrorism is only a tangential aspect of the overall invention. Therefore the petition does not rise to the level intended by the Rule.

Further correspondence with respect to this matter should be addressed as follows:

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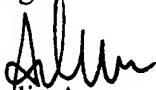
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By FAX: (571) 273-8300

Telephone inquiries concerning this decision should be directed to Irvin Dingle at 571-272-3210.

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

The application is being forwarded to the Technology Center Art Unit 3743 for action in its regular turn.


Amelia Au
Petitions Examiner
Office of Petitions